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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,412	10/02/2003	Andreas Meudt	2001DE307/D	8466
7590	05/25/2005	EXAMINER		
DAVIS, ZINNA NORTHINGTON			ART UNIT	
			1625	PAPER NUMBER

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/677,412	MEUDT ET AL.
	Examiner Zinna Northington Davis	Art Unit 1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) not drawn to the elected subject matter is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1,2 and 8 is/are rejected.
- 7) Claim(s) 3-7 and 9-20 is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. 10/171,444.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/03; 3/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. In the response filed March 11, 2005, Applicants have elected the compound of Example 19 as the preferred species.
2. Claims not drawn to the elected subject matter are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 11, 2005.
3. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).
4. Claims 1-20 are Markush claims which are generic to the elected invention. These Markush claims lack unity of invention. Accordingly, the Markush type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. See MPEP 803.02.
5. Claims 1-20 are objected on the grounds that the claims are drawn to an improper Markush group. In re Harnish, 206 USPQ 300, states that a unity of invention exists where compounds included within a Markush group(1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.

In the instant case, the claimed subject matter does not share a substantial structural feature disclosed as being essential to that utility.

The requirement for a proper Markush claim is that it includes only substances that in their physical, chemical and physiological characteristics are functionally equivalent. The members of the instant Markush groups possess widely different, physical and chemical properties. The compounds are not considered functionally equivalent and are so diverse that they demonstrate dissimilar and unrelated properties. The mere fact that there is structural similarity in pharmaceutical agents is not in itself reason to render all the embodiments functionally equivalent.

The improper Markush groups are X^1 - X^5 .

6. The examined subject matter is as follows:

A compound of formula (I) and (II) where the symbols X^1 - X^5 are each carbon with at least one X^1 - X^5 is nitrogen. Amending the claims to the examined subject matter would overcome the improper Markush rejection.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 2, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. At claims 1 and 8, the radical $-C_{aryl,alkyl}$ cannot represent alkoxy. Clarification is appreciated.

B. At claims 1 and 2, what is intended for the R group (all occurrences)?

9. Claims 3-7 and 9-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The Information Disclosure Statements filed October 2, 2003 and March 3, 2005 have been considered. The references alone or in combination form do not teach nor suggested a process for preparing structurally similar compounds as the examined subject matter. According, no rejections based upon prior art are made.

11. Reference N is further cited to sow the state of the art in the preparation of pyridine compounds.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna N. Davis whose telephone number is 571-272-0682.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Znd
05.23. 2005


ZINNA NORTHINGTON DAVIS
PRIMARY EXAMINER